

REMARKS

I. 35 U.S.C. §103

In the Office Action, the Examiner has rejected Claims 1-6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gorthala, U.S. Patent 6,189,246, in view of Gabbard, U.S. Patent 6,205,432, in view of Albert et al, U.S. Patent 6,252,564, and Stone et al., U.S. Patent 6,446,045 and Cummings et al., U.S. Patent 6,345,260.

Applicant respectfully disagrees. Applicants claim an apparatus for a wireless electronic billboard commerce system. The system has a plurality of electronic billboards. Each electronic billboard has a video display for showing a video stream. A billboard computer is coupled to and controls the video display. A billboard antenna is coupled to the billboard computer for transferring video data to the billboard computer wirelessly. The system also has a main computer. The main computer is connected to a global computer network such as the World Wide Web. A communication system is provided and comprises a communication server and a transmission antenna. The communication server is connected to the main computer and the transmission antenna is connected to the communication server. A video advertisement stored as a digital file is uploaded to the main computer through the global computer network. The main computer transfers the digital file to the communication system. The communication system transmits the digital file as a signal. The billboard antenna

receives the signal. The billboard computer processes the signal and the billboard computer shows the signal on the video display as a video stream. An access purchase system provides a table of billboard information. The table of billboard information includes a listing of available locations, a listing of available time periods, and a listing of prices. The access purchase system searches a database to determine if the electronic billboard is available to display said advertisement at a requested location and a requested time.

In contrast, Gorthala fails to disclose or anticipate a video display for displaying a video stream as claimed by Applicants. Gorthala discloses a board having a plurality of holes for rod members to be extended or retracted from. Gorthala is incapable of displaying any type of video stream.

Gorthala also fails to disclose a main computer coupled to a global computer network. The main computer is also coupled to the billboard computer wirelessly. The main computer verifies authenticity of a user and allows compilation of video data to form a video stream to be displayed.

Gorthala also fails to disclose an access purchase system. The Examiner acknowledges this but states that Cummings teaches such a system and it would have been obvious to combine these references. Applicant respectfully disagrees. Cummings discloses a scheduling interface system for medical professionals. Nowhere is it disclosed or anticipated that Cummings is to be used for reviewing available billboard space and renting the use of the

billboard. Both of these patents are in different classifications. No one skilled in the art would have thought about combining functions of a scheduling interface for medical professionals with an advertising system.

The legal standard for obviousness under 35 U.S.C. 103 has been the subject of much analysis. The Federal Circuit has enunciated several guidelines in making a Sec. 103 obviousness determination.

A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.

In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051 (C.C.P.A. 1976)).

{T}he examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. "{The Examiner} can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." (Emphasis added)

In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984) and In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1988))).

For the Examiner to establish a prima facie case of obviousness, the Examiner must contend that the teachings from the prior art itself or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

Perhaps the Examiner somehow believes that one of ordinary skill in the art could conceivably combine the five cited references (in different classifications) to produce Applicants' claimed invention. But the Federal Circuit has held that

obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. (Emphasis added)

In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (citations omitted).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." (Emphasis added) But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." (Emphasis added)

In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988) (citing In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q.871, 881 (C.C.P.A. 1981) and ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)).

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Lindemann, Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984)).

Applicant respectfully yet strenuously contends that the Examiner has shown no teaching nor suggestion in any one or more of the cited references or elsewhere of Applicant's claimed apparatus to support a conclusion of obviousness.

By maintaining the five reference combination obviousness rejection, the Examiner has fallen into the common trap of hindsight reconstruction, which has been frequently denounced by

the Federal Circuit as inappropriate to support a finding of obviousness.

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decisionmaker to return to the time the invention was made. "the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-51, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988) (quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547-548 (Fed. Cir. 1985)).

It is clear from the Examiner's rejection that, absent the "blueprint" of Applicants' disclosure, the prior art has no suggestion or teaching of Applicants' claimed invention. The Federal Circuit has also stated:

It is improper to use the patent as an instruction manual to lead to elements of the prior art.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987).

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885, 188 (Fed. Cir. 1991)).

It is very clear from the Examiner's language that Applicant's claimed invention is only rendered invalid for obviousness if the Applicant's claimed invention is used as an instruction manual, or template, for modifying the cited prior art. Absent the knowledge gleaned from Applicant's disclosure, there is no suggestion or teaching in the cited prior art or in the general knowledge in the art to support the Examiner's assertion that

Applicant's claimed invention would have been obviousness to one of ordinary skill in the art. The Federal Circuit has also stated:

When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985)).

The Examiner has cited no reason for modifying the cited references to allegedly achieve Applicant's claimed invention other than the knowledge gleaned from Applicant's disclosure. For this reason the Examiner has failed to establish a prima facie case of obviousness based on a combination of these specific references.

Applicant respectfully submits that the reasons stated above overcomes the Examiner's rejection under 35 U.S.C. § 103(a). Such action is earnestly solicited.

II. Conclusion

Applicant respectfully submit that Applicant's claimed invention is deserving of patent protection because it describes a useful and functioning apparatus which is patentably distinguishable over the prior art.

In conclusion, Applicants respectfully submit that this Amendment Letter, in view of the Remarks offered in conjunction therewith, are fully responsive to all aspects of the objections and rejections tendered by the Examiner in the Office Action. Applicants respectfully submit that he has persuasively demonstrated that the above-identified Patent Application, including Claims 11-18 are in condition for allowance. Such action is earnestly solicited.

If the foregoing does not place the case in condition for immediate allowance, the Examiner is respectfully requested to contact the undersigned for purposes of a telephone interview.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 23-0830.

Respectfully submitted,



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